



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,184	11/13/2003	Gerald A. Case	JCA1-H23	9388

7590

08/25/2005

Karl M. Steins
Steins & Associates
Suite 120
2333 Camino del Rio South
San Diego, CA 92108

EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/714,184	Applicant(s) CASE, GERALD A.	
	Examiner Michael W. Talbot	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant is advised that should claims 1 and/or 2 be found allowable, claims 14 and/or 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Specification

1. The disclosure is objected to because of the following informalities:

Refer to page 7, lines 8 and 9, character reference "head 26" should be changed to --head 14--.

Refer to page 7, line 19, character reference "face 34" should be changed to --face 26--.

Appropriate correction is required.

Claim Objections

2. Claim 14 is objected to because of the following informalities:

Refer to claim 14, line 3, the phrase "defining an circular" should be changed to read --defining a circular--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3722

Regarding claim 1, it is unclear as to the claimed limitation defined by the phrase "along a longitudinal axis a base end and a cutting end". For examination purposes, it has been best understood that the phrase should read --along a longitudinal axis, a base end and a cutting end--.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,9,14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uffman '407 in view of Bingham et al. '392. Uffman '407 shows in Figures 1-4 a tool assembly (10) comprising a mandrel having an elongated shaft end (20) defining a generally constant diameter over its entire length and a head end (17) defining an outer diameter and a face, a cutting tool (18) defining a generally cylindrical shape with a circular cross-section having a base end (26) and a cutting end (30) terminating in at least one pointed tip (edge 31) and an attachment means (25,27,28, bolt 22, threaded bore 21 and magnetic forces (col. 2, lines 60-62)) for attaching the cutting tool to the mandrel. Uffman '407 further shows the cutting tool having a diameter less than the mandrel head diameter (Fig. 2). Uffman '407 shows the tool assembly being attachable to a rotary power means (drill 12) through chuck (11) for cutting holes (15) in a sheet (14). Uffman '407 lacks the cutting tool being a punch tool. Bingham et al. '392 shows a punch tool (10) for use with sheet metal (abstract) having a base end (22) and a cutting end (20), a pair of opposing trough portions (28,30), a pair of tips (54,56) and a central threaded hole (16,18) for attachment to a tool holder. In view of this teaching of Bingham et al. '392, it is considered to have been obvious to replace the cutting tool of Uffman '407 with

Art Unit: 3722

another well-known cutting tool shown in Bingham et al. '392 to provide a greater versatility in cutting materials.

Claims 1,2,9,14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of Bingham et al. '392, further in view of Uffman '407. Kaiser '023 shows in Figure 1 a tool assembly comprising a mandrel (11) having an elongated shaft end (10) and a head end (15) defining an outer diameter and a face, a cutting tool (17) defining a generally cylindrical shape with a circular cross-section having a base end and a cutting end terminating in at least one pointed tip (31) and an attachment means for attaching the cutting tool to the mandrel (col. 1, lines 65-67). Kaiser '023 further shows the cutting tool having a diameter less than the mandrel head diameter (Fig. 2). Kaiser '023 lacks the cutting tool being a punch tool and the elongated shaft end defining a generally constant diameter over its entire length. Bingham et al. '392 shows a punch tool (10) for use with sheet metal (abstract) having a base end (22) and a cutting end (20), a pair of opposing trough portions (28,30), a pair of tips (54,56) and a central threaded hole (16,18) for attachment to a tool holder. In view of this teaching of Bingham et al. '392, it is considered to have been obvious to replace the cutting tool of Kaiser '023 with another well-known cutting tool shown in Bingham et al. '392 to provide the desired machining. Uffman '407 shows in Figures 1-4 a tool assembly (10) comprising a mandrel having an elongated shaft end (20) defining a generally constant diameter over its entire length. In view of this teaching of Uffman '407, it is considered to have been obvious to replace the elongated tapered shaft configuration of Kaiser '023 in view of Bingham et al. '392 to a more cylindrical configuration of Uffman '407 to provide a more adaptable shaft to attach to a wide variety of power means to get the desired machining.

Claims 1-4,9-11,14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of McCutcheon '394, further in view of Uffman '407.

Art Unit: 3722

Kaiser '023 lacks the cutting tool being a punch tool having a pair of opposing arcuate portions and a pair of tips in alternating space relation with each other and the elongated shaft end defining a generally constant diameter over its entire length. McCutcheon '394 shows in Figure 1 a grooved punch tool (10) with a pair of opposing arcuate portions (17) with a pair of pointed tips (at 11 defined by angle α) in alternating space relation with each other. In view of this teaching of McCutcheon '394, it is considered to have been obvious to replace the cutting tool of Kaiser '023 with another well-known cutting tool shown in McCutcheon '394 to provide the desired machining. Uffman '407 shows in Figures 1-4 a tool assembly (10) comprising a mandrel having an elongated shaft end (20) defining a generally constant diameter over its entire length. In view of this teaching of Uffman '407, it is considered to have been obvious to replace the elongated tapered shaft configuration of Kaiser '023 in view of McCutcheon '394 to a more cylindrical configuration of Uffman '407 to provide a more adaptable shaft to attach to a wide variety of power means to get the desired machining.

Claims 5-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of McCutcheon '394 in view of Uffman '407, and further in view of Morse '310. Kaiser '023 in view of McCutcheon '394 in view of Uffman '407 lacks the attachment means being a threaded bolt. Morse '310 shows in Figure 7 a threaded bolt (5) for attaching the cutting tool to the body (col. 3, lines 40-49). In view of this teaching of Morse '310, it is considered to have been obvious to replace the attachment means of Kaiser '023 in view of McCutcheon '394 in view of Uffman '407 with another well-known attachment means shown in Morse '310 to provide the desired securement between the cutting tool and the mandrel body.

Response to Arguments

4. Applicant's arguments filed in amendment dated 15 June 2005 have been fully considered but they are not persuasive.

Art Unit: 3722

Examiner respectfully understands Applicants assertion that Kaiser '023 does not disclose "a punch design", that Bingham '392 does not disclose "any external apparatus (i.e. a mandrel)", that McCutcheon '394 does not disclose "a mandrel or it's configuration" and that Morse '310 does not "disclose a punch or its details, a mandrel or any structural details, nor any punching method or approach". However the mere fact that a reference does not disclose a certain element does not prevent it from being used in combination with a secondary teaching reference. Applicant's arguments do not address the rejection and therefore are not germane to the rejection.

Patentability of claims 1,2,9,14 and 16-18

In response to applicant's argument that Kaiser '023 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a punch tool performs an equivalent function as a rotating cutting tool (i.e. removal of material from an object) and therefore is considered to be analogous in the cutting tool art.

Examiner respectfully disagrees with Applicant's arguments that Bingham '392 does not disclose pointed tips (see Applicant's arguments on page 7 under title "Bingham", last line stating "result in to form two points at the outer perimeter of the punch").

Method claim 9 is further supported as shown above by previously cited reference Uffman '407 which discloses the cutting tool (10) be attached (11) to a power driving means (12) and shown in Figure 1 being applied against a sheet (14) to create a hole (15).

Patentability of claims 1,2,9,14 and 16-18

Art Unit: 3722

Examiner respectfully disagrees with Applicant's arguments that McCutcheon '394 does not disclose pointed tips. Applicant is directed to Figures 1,3,5 and 7 showing the pointed tips created by the planar surface inclined at angle α (and labeling as "tip" in Figures 5 and 7).

Method claim 9 is further supported as shown above by previously cited reference Uffman '407 which discloses the cutting tool (10) be attached (11) to a power driving means (12) and shown in Figure 1 being applied against a sheet (14) to create a hole (15).

Patentability of claims 5-13 and 15

In response to applicant's argument that Morse '310 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a punch tool performs an equivalent function as a rotating cutting tool (i.e. removal of material from an object) and therefore is considered to be analogous in the cutting tool art.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3722

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

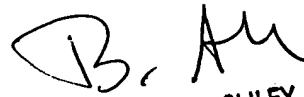
6. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722
9 August 2005



BOYER D. ASHLEY
PRIMARY EXAMINER